

Application No.: 10/670,974  
Attorney Docket No.: 21882-0001-U1

**D. AMENDMENTS TO THE DRAWINGS**

There are no amendments to the Figures. Per a telephone conversation with Examiner Hoge on January 11, 2005, Figure 1 does clearly show the limitation of attachment means being provided on two adjacent sides of the frame member. Thus, there is no requirement for submission of new drawings, and the Replacement drawings submitted August 29, 2005 should be acceptable for issuance of the application as a patent.

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### **E. REMARKS**

The present invention is directed to picture frame having a frame member having a front surface and a rear surface separated by a perimeter edge, the frame member adapted to receive and retain a transparent member. The frame member is adapted for removable attachment to a backing member having a display surface and a rear surface separated by a side edge. The rear surface of the backing member comprises mounting means for mounting on a mounting surface. A variety of attachment means, and combinations thereof, are disclosed herein for removably attaching the front member and the backing member, without the need to remove the backing member from a mounting surface.

#### **Status of the Claims**

As of the mailing date of the Final Office Action, Claims 1 – 20 were pending in the subject application. By this amendment, claims 1-12 and 14-19 are canceled, and claims 13, and 20 remain pending. Claims 13 and 20 were previously allowed by the Examiner.

Applicant has added new claim 21 which is based upon the subject matter of allowed claim 20. Applicant requests consideration by the Examiner of that claim in light of the previous allowances and rejections.

#### **35 U.S.C. 102(b) Rejections**

The Examiner continued his rejection of claims 1-3, 7-9 and 16 as being anticipated under 35 U.S.C. § 102(b) by U.S. Patent 5,353,536 to Erber et al.(hereinafter "Erber"). By this Amendment, Applicant has canceled those claims without prejudice. For this reason, Applicant requests that the Examiner remove the rejection under 35 U.S.C. §102(b).

#### **35 U.S.C. 103(a) Rejections**

The Examiner has again rejected claims 4-6 and 17 under 35 U.S.C. §103(a) as being unpatentable over Erber in view of U.S. Patent 6,574,896 to Howell ("Howell"). By this Amendment, Applicant has canceled those claims without prejudice. For this reason, Applicant requests that the Examiner remove the rejection under 35 U.S.C. §103(a).

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The Examiner has again further rejected claims 10-11 under 35 U.S.C. §103(a) as being unpatentable over Erber in view of U.S. Patent 5,419,063 to Lane ("Lane"). By this Amendment, Applicant has canceled those claims without prejudice. For this reason, Applicant requests that the Examiner remove the rejection under 35 U.S.C. §103(a).

The Examiner further rejected claims 10-12 under 35 U.S.C. §103(a) as being unpatentable over Erber in view of U.S. Patent 5,353,536 to Rousseau ("Rousseau"). By this Amendment, Applicant has canceled those claims without prejudice. For this reason, Applicant requests that the Examiner remove the rejection under 35 U.S.C. §103(a).

The Examiner further rejected claims 14-15 under 35 U.S.C. §103(a) as being unpatentable over Erber and design selection. By this Amendment, Applicant has canceled those claims without prejudice. For this reason, Applicant requests that the Examiner remove the rejection under 35 U.S.C. §103(a).

Lastly, the Examiner rejected claims 18-19 under 35 U.S.C. §103(a) as being unpatentable over Erber in view of Howell, and further in view of Rousseau. By this Amendment, Applicant has canceled those claims without prejudice. For this reason, Applicant requests that the Examiner remove the rejection under 35 U.S.C. §103(a).

#### **New Claim 21**

Claim 21 is presented by this amendment. Claim 21 is derived from allowed claim 20, with slight modification to more fully describe to the groove limitations of the display surface. Applicant submits that the new claim is within the scope of the allowed claims, and that the prior art of record clearly does not teach all of the limitations of new claim 21. Applicant submits that since the Examiner has not identified any prior art teaching of a groove and band provided in a display surface, that Applicant is entitled to the matter of claim 21, wherein the groove is not limited to one having a raised portion therein.

The claimed artwork retaining means comprising elastic bands in two parallel grooves are claimed as a feature of the display surface of the backing member. In contrast, the elastic bands of Rousseau are elements entirely separate from the frame and backing members. The elastic

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bands of Rousseau are simply wrapped around the frame and backing to frictionally hold those two frame elements together as a unitary assembly - they are not a feature of any artwork display surface of the backing member.

In the disclosed capacity of Rousseau, the elastic bands of Rousseau are at best similar in function to Applicant's attachment means for removably attaching the frame member to the backing member. There is no absolutely no equivalent in Rousseau to Applicant's artwork retaining means as a feature of the backing member, and certainly not as a feature of the display surface. Accordingly, new claim 21, which adds readily distinguishable and unprecedented artwork retaining means limitations, should be allowed. Applicant requests consideration and allowance of claim 21.

Applicant submits that since the Examiner has not identified any prior art teaching of a groove and band provided in a display surface, that Applicant is entitled to claim 21, wherein the groove is not limited to one having a raised portion therein.

#### Allowable Subject Matter

The Examiner indicated that claims 13 and 20 are allowed. By the previous amendment, Applicant amended claim 13 and claim 20 to stand as independent claims correcting language to overcome the 35 U.S.C. §112, 2<sup>nd</sup> paragraph and to incorporate all the limitations of their respective base claims and intervening claims. Therefore, it is submitted that claim 13 and claim 20 remain allowable.

As previously described, Applicant has also presented new claim 21 only to incorporate the limitations of the grooves and elastic bands taught by the specification. Therefore, Applicant submits that no new matter results from this new claim.

#### Amendments to the Drawings

The Examiner objected to the drawings under 37 C.F.R. 1.83(a), requiring that "the drawings must show every feature of the invention specified in the claims." The Examiner has requested that "therefore, the attachment means being provided on two adjacent sides of the frame member (claim 1)."

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There are no amendments to the Figures, and none are required. Per a telephone conversation with Examiner Hoge on January 11, 2005, Figure 1 does clearly show the limitation of attachment means being provided on two adjacent sides of the frame member. Thus, there is no requirement for submission of new drawings, and the Replacement drawings submitted August 29, 2005 should be acceptable for issuance of the application as a patent. Applicant respectfully requests the Examiner to withdraw the objection under 37 C.F.R. 1.83(a).

#### F. CONCLUSION

In view of the above, Applicant respectfully requests entry of this amendment, reconsideration of the Application and withdrawal of the outstanding rejections. As a result of the amendments and remarks presented herein, Applicant respectfully submits that independent claims 13, 20, and 21 are neither anticipated by the cited prior art nor rendered obvious.


As the claims are not anticipated by nor rendered obvious in view of the applied art, Applicant requests withdrawal of the outstanding rejections and allowance of claims 13, 20 and 21. If the Examiner believes that prosecution of this Application could be expedited by a telephone conference, the Examiner is encouraged to contact applicant's attorney at the phone number listed below.

The Commissioner is hereby authorized to charge any additional fees and credit any overpayments to Deposit Account No. 50-1059.

Respectfully submitted,

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